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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/830,923

08/09/2001

Keiichi Imamura

2001-0555A

5080

513

7590

03/25/2004

WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

EXAMINER

ROBINSON, BINTA M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 03/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/830,923	Applicant(s) IMAMURA ET AL.	
	Examiner Binta M. Robinson	Art Unit 1625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13, 15-26 and 29-32 is/are pending in the application.
- 4a) Of the above claim(s) 20-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13, 15, 17, 19 and 29 is/are rejected.
- 7) ☒ Claim(s) 30-32 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>05/3/01</u> . | 6) <input type="checkbox"/> Other: ____. |

Detailed Action

The 112, first paragraph rejection of claims 1-19, 27, 28 and the 112, second paragraph rejection of claims 17-19 made at paper no. 7 are withdrawn in light of applicant's amendment filed.

The examiner has examined elected group I, drawn to claims 1-13, 15, 17, 19 and 29-32 to the compound of formula I where R1 is as claimed, R2 is as claimed, A is as claimed, R3 is H, cycloalkyl, cycloalkenyl, and aryl, a composition, and process of preparing a compound of formula I as defined above.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Hecker et. al. (See Reference A). Hecker discloses the instant compound, 2-pyridinecarboxamide, 3-hydroxy . At pages 1-47, see the instant compound.

(new rejections)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is

most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 15, 17, 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. While the specification describes the use of the claimed compound as a pesticidal and antifungal agent, it does not show its effectiveness in the treatment of all other harmful organisms. Some organisms that can be harmful to one host may be beneficial to another host. The applicant does not state the host that is being treated in claim 15 and 19. The applicant gives no description as to how the composition can prevent or exterminate beasts. Claim 17 is also contradictory because it is a composition claim, and yet by definition, a composition claim must contain at least the active ingredient and an inert, non-toxic carrier. However, the composition in claim 17 only contains the picolinamide compound of claim 1.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15, 17, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A. In claim 15, line 1, page 8 of the amendment, the phrase "harmful organisms" and in claims 17 and 18, line 1, the phrase "harmful organism control composition" is indefinite. Harmful organisms can be fungi, bacteria, or many other organisms. Some organisms that can be harmful to one host, may be beneficial to another host. What harmful organisms is the applicant claiming? The applicant does not specify the host that the compound is being applied to for controlling the harmful organisms.

B. In claim 19, line 2, page 9, the term "beasts" is indefinite. The applicant does not state the target host to which the composition is being applied to control the beasts. What beasts is the composition preventing or exterminating? Beasts can be as far ranging as "cats" or "lions".

C. In claim 4, lines 2-3, page 3, the phrase "wherein alkoxy or haloalkoxy represented by R1 is" is indefinite. It is unclear and ambiguous as to whether or not R1 is being limited to the substituents claimed in claim 4, or if the substituents in claim 4 are being further defined and limited, while R1 can still equal all of the substituents that it is in claim 1.

D. In claim 29, line 4, page 13, the phrase "as defined above" is indefinite. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ca 127:81061 et. al. (See Reference U). by Ca 127:81061 discloses the instant compound, 2-pyridinecarboxamide, N-cyclohexyl-3-methoxy. At page 3 , see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Ca 125:301567 et. al. (See Reference V). Ca 125:301567 discloses the instant compound, 2-pyridinecarboxamide, N-[2,6-bis(1-methylethyl)phenyl]-3-methoxy. At page 3, see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Renk et. al. (See Reference B). Renk et. al. discloses the instant compound, 2-pyridinecarboxamide, 3-hydroxy. At column 8, line 16, see the instant compound.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim(s) 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumann et. al. (See Reference C). Baumann et. al. discloses the instant compound, Picolinamide, 3-butoxy. At column 3, line 38, see the instant compound.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(f) he did not himself invent the subject matter sought to be patented.

Claims 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(f) because the applicant did not invent the claimed subject matter. See Backhaus et. al. (Reference N). Backhaus discloses the instant compound, 2-pyridinecarboxamide, N-[4-(2,4-dichlorophenoxy)phenyl]-3-hydroxy-4-methoxy. At page 12, line 19, see the instant compound, Beispiel 1. The specification nor do the claims disclose this species, although a genus encompassing this species is disclosed and claimed. Because the applicant did not disclose this species, the question as to who was the first to invent this compound must be raised.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(g)(1) during the course of an interference conducted under section 135 or section 291, another inventor involved therein establishes, to the extent permitted in section 104, that before such person's invention thereof the invention was made by such other inventor and not abandoned, suppressed, or concealed, or (2) before such person's invention thereof, the invention was made in this country by another inventor who had not abandoned, suppressed, or concealed it. In determining priority of invention under this subsection, there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claim(s) 1, 2, 3, 4, 5, 6, 7, 8, 9-13 are rejected under 35 U.S.C. 102(g) as being anticipated by Backhaus et. al. (See Reference N). Backhaus discloses the instant compound, 2-pyridinecarboxamide, N-[4-(2,4-dichlorophenoxy)phenyl]-3-hydroxy-4-methoxy. At page 12, line 19, see the instant compound, Beispiel 1.

The IDS filed 5/3/01 has been considered.

Claims 30-32 are objected to because they are based on a rejected claim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (703) 306-5437. The examiner can normally be reached on M-F (9:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on (703)308-4698. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7922 for regular communications and (703)308-7922 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0193.

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Binta Robinson

March 19, 2004



CEILA CHANG
PRIMARY EXAMINER

GROUP 1200-16 25